



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,356	04/06/2000	Brian Totty	50269-036	8053

29989 7590 02/25/2005

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

GOLD, AVI M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/544,356	Applicant(s) TOTTY ET AL.	
	Examiner Avi Gold	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received on September 7, 2004 has been entered and fully considered.

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,317,761, further in view of Eilbott et al., U.S. Patent No. 6,553,393.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract).

As to claims 1, 25, and 49, Landsman teaches a method, computer readable medium, and a computer system for allowing a porthole engine to deliver unrequested content to users that access requested content through the porthole engine, comprising the steps of:

receiving, from a browser executing on a client, an initial request for requested content (col. 25, lines 46-63; Landsman discloses a user at a client browser requesting a web page);

wherein said initial request is received at said porthole engine (col. 8, lines 1-40; Landsman discloses a request routed to a proxy server);

wherein said client is connected to a network through said porthole engine (col. 8, lines 1-40; Landsman discloses a client PC connected to a proxy server);

wherein said requested content resides on an origin server located separate from said porthole engine on said network (col. 8, lines 1-40; Landsman discloses a proxy server directing a request to a web server); and

said porthole engine responding to said initial request by sending to said client data that causes said requested content and said unrequested content to appear on a display screen of said client (col. 1, lines 26-35; Landsman discloses advertisements transparently downloaded to a client computer and then displayed by a browser).

Landsman fails to teach the limitation further including data generated by the porthole engine.

However, Eilbott teaches managing references to embedded objects in a markup language data stream (see abstract). Eilbott teaches the use of a proxy server generating a list of resources (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a porthole engine to generate

data. One would be motivated to do so because it avoids the transfer of data to other servers, which would speed up the generation of data and be more efficient.

Regarding claims 2, 26, and 50, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine web page content of said requested content to be modified to encapsulate said requested content within a paneled frame (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses a browser displaying content in frames).

Regarding claims 3, 27, and 51, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to reserve space in the web page to display said unrequested content (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses frame-targeted ad play).

Regarding claims 4, 28, and 52, Landsman teaches the method, computer readable medium, and a computer system of claims 3, 27, and 51 wherein the space reserved in the web page is selected from a group consisting of:

- the top of the web page;

- the bottom of the web page; and

- a combination of the top of the web page and the bottom of the web page (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 5, 29, and 53, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to pop-up one or more display windows to display said unrequested content (col. 32, lines 22-49; Landsman discloses a pop-up window with advertisements).

Regarding claims 6, 30, and 54, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to replace a portion of said requested content with the unrequested content (col. 1, lines 26-35; Landsman discloses an advertisement displayed on an interstitial basis).

Regarding claims 7, 31, and 55, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first portion of a content display region of said browser (col. 9, lines 53-63; col. 10, lines 61-65; Landsman discloses a requested web page displayed to a user); and

said unrequested content appears on a second portion of said content display region of said browser (col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 8, 32, and 56, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first display window of said client (col. 9, lines 53-63; col. 10, lines 61-65); and

said unrequested content appears on a second display window of said client (col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

As to claims 9, 33, and 57, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein said porthole engine determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences in browsers, components of requested web pages, and versions of the browsers (col. 21, lines 10-28; Landsman discloses ad selection based on user specific info collected from and associated with the user operating the browser).

Landsman fails to teach the limitation further including the content format chosen by the porthole engine.

However, Eilbott teaches the use of a proxy server to choose and translate the format of a page (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a porthole engine to choose a content format.

Regarding claims 10, 34, and 58, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the step of sending data to said client includes the step of:

sending frame data to said client ;

wherein said frame data defines a plurality of frames;

wherein said plurality of frames includes a first frame and one or more other frames (col. 31, lines 65-67; col. 32, lines 1-49);

wherein said frame data further specifies that said requested content is to be displayed in said first frame, and that said unrequested content is to be displayed in said one or more other frames (col. 9, lines 53-63; col. 10, lines 61-65; col. 31, lines 65-67; col. 32, lines 1-49).

As to claims 11, 35, and 59, Landsman teaches the method, computer readable medium, and a computer system of claims 10, 34, and 58 further comprising the steps of:

the porthole engine receiving a series of subsequent requests from the browser in response to the browser decoding said frame data, said series of subsequent requests including a second request for said requested content (col. 8, lines 41-67; Landsman discloses downloading restarted after another request); and

the porthole engine responding to said second request for said requested content by requesting said requested content from said origin server and delivering said

requested content to said browser (col. 19, lines 25-63; Landsman discloses an agent server downloading contents from another server).

Landsman fails to teach the limitation further including requests received from a browser processed by a proxy server.

However, Eilbott teaches the use of the proxy server requesting a page from the origin server and delivering it to the requesting browser (col. 4, lines 22-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a proxy server to process requests received from a browser.

Regarding claims 12, 36, and 60, Landsman teaches the method, computer readable medium, and a computer system of claims 11, 35, and 59 wherein said porthole engine determines that said second request for said requested content is not an initial request for said requested content by using information contained in the URL associated with said initial request and with said second request (col. 7, lines 66-67; col. 8, lines 1-40; Landsman discloses the proxy server providing files from cache to other client PCs if they request the same files).

Regarding claims 13, 37, and 61, Landsman teaches the method, computer readable medium, and a computer system of claims 10, 34, and 58 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial

request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10;

Landsman discloses an agent checking the URL of a request); and

the step of sending frame data is performed in response to determining that said initial request is not a request for an embedded item (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 16, 40, and 62, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10); and

said porthole engine sends data that causes said unrequested content to appear on a portion of said content display region of said browser in response to determining that said initial request is not a request for an embedded item (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 17, 41, and 65, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 further comprising the step of using information about a particular user to tailor the unrequested content to that particular user (col. 21, lines 10-28).

Regarding claims 18, 42, and 66, Landsman teaches the method, computer readable medium, and a computer system of claim 17, 41, and 65 wherein the information about the particular user is selected from a group consisting of information available to owners of the porthole engine;

information about the requested content; and

a combination of the information available to the owners of the porthole engine and the information about the requested content (col. 21, lines 10-28).

Regarding claims 19, 43, and 67, Landsman teaches the method, computer readable medium, and a computer system of claim 1, 25, and 49 further comprising the step of identifying the users to personalize the unrequested content (col. 21, lines 10-28; Landsman discloses advertisements specifically targeted to the user).

3. Claims 14, 15, 38, 39, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606,653.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract).

As to claims 14, 15, 38, 39, 63, and 64, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman fails to teach the limitation further including the changing a target attribute of a link in an embedded frame document to affect frame behavior.

However, Ackermann teaches the updating of embedded links or hotspots in source Web pages to reflect the new URLs of moved target Web Pages (see abstract). Ackermann teaches the use of a URL of a link being changed to point to a new URL (col. 5, lines 25-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Ackermann to change a target attribute of a link. One would be motivated to do so because it would allow for the proper URL of the link to be shown.

4. Claims 20, 44, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Underwood, U.S. Patent No. 6,704,873.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 20, 44, and 68, Landsman and Eilbott teach the method of claims 19, 43, and 67.

Landsman and Eilbott fail to teach the limitation further including the method of Claim 19 wherein the step of identifying the users is performed by a method selected in a group consisting of:

attaching cookies to web pages that are browsed by a particular user;
observing the radius authentication transactions and the resulting network address assigned to the client;
tracking network addresses assigned to the users; and
authenticating the user.

However, Underwood teaches secure gateway interconnection in an e-commerce based environment (see abstract). Underwood teaches the use of cookie authentication (col. 140, lines 29-46; col. 141, lines 30-45), a RADIUS server performing authentication and allowing traffic from the client (col. 287, lines 65-67; col. 288, lines 1-28), tracking of an IP address (col. 10, lines 3-18), and authenticating the identity of a user (col. 50, lines 34-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Underwood to attach cookies to web pages that are browsed by a particular user, observing the radius authentication transactions and the resulting network address assigned to the client, tracking network addresses assigned to the users, and authenticating the user. One would be motivated to do so because they are all efficient methods of identifying a user and personalizing unrequested content for them.

5. Claims 21-23, 45-47, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Markus, U.S. Patent No. 6,499,042.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 21-23, 45-47, and 69-71, Landsman and Eilbott teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Eilbott fail to teach the limitation further including the automatically filling in one or more fields on a requested web page by using a database coupled to the porthole engine.

However, Markus teaches an improved process that allows an entity to automatically release personal data to other entities connected via a computer network (see abstract). Markus teaches the use of a selective proxy server for automatically filling in an online form and a personal data storage component used to for the information to fill the forms in with (col. 1, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Markus to automatically fill in one or more fields on a requested web page by using a database coupled to the porthole engine. One would be motivated to do so because it would allow the user to fill in forms without entering anything.

6. Claims 24, 48, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Shapiro et al., U.S. Patent No. 5,991,810.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 24, 48, and 72, Landsman and Eilbott teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Eilbott fail to teach the limitation further including the use of a content filtering technology based on identities of the users.

However, Shapiro teaches user name authentication for gateway clients accessing a proxy cache server (see abstract). Shapiro teaches the use of automatically restricting access by unauthorized users to specified web information (col. 1, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Shapiro to use a filter to allow only authorized users access to particular web pages. One would be motivated to do so because it would allow a way to make certain web pages exclusive.

Response to Arguments

7. Applicant's arguments with respect to claims 1-72 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed September 7, 2004 have been fully considered but they are not persuasive.

Regarding the argument to claims 14, 15, 38, 39, 63, and 64, the applicant argues that the reference, Ackermann, does not disclose the step of rewriting a link in an embedded frame document to affect frame behavior. The examiner disagrees as seen in column 5, lines 25-44, there is the use of a URL of a link being changed to point to a new URL, which inherently affects the frame behavior.

Regarding the argument to claims 22, 46, and 70, the applicant argues that the reference, Markus, does not disclose the step of automatically filling in said one or more fields of said web page form upon determining that a web page being deliver through said porthole engine is associated with said web page form and is registered in the porthole engine as fillable. The examiner disagrees as seen in column 1, lines 40-57, there is the use of a selective proxy server for automatically filling in an online form.

Regarding the argument to claims 23, 47, and 71, the applicant argues that in the reference Markus, the personal data storage component does not correspond to the database, which provides the web page forms. The examiner disagrees; the combination of Landsman and Markus would provide the coupling of the personal storage component with the proxy server.

Regarding the argument to claims 24, 48, and 72, the applicant argues that the reference, Shapiro, does not disclose a porthole engine which restricts access to particular web pages by using filtering technology based on identities of the users. The examiner disagrees as seen in column 1, lines 56-67, there is the use of automatically restricting access of unauthorized users to specified web information.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,854,897 to Radziewicz et al.

U.S. Pat. No. 6,128,655 to Fields et al.

U.S. Pat. No. 6,338,059 to Fields et al.

U.S. Pat. No. 6,466,975 to Sterling.

U.S. Pat. No. 6,128,651 to Cezar.

U.S. Pat. No. 6,636,247 to Hamzy et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG


ARJETTENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100